Attorney Docket No. F1103/1(V)
Serial No.: 10/057,089
Filed: January 25, 2002
Confirmation No.: 3328

BRIEF FOR APPELLANTS

Sir:

This is a Brief on Appeal from the Examiner's Final Rejection concerning the above-identified application. The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all required fees under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18; 37 C.F.R. §1.136.

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I. REAL PARTY IN INTEREST

The Real Party in Interest in this Appeal is Unilever Bestfoods North America, Division of Conopco, Inc., a corporation of the State of New York.

II. RELATED APPEALS AND INTERFERENCES

Neither the Appellants, their legal representatives nor the Assignee are aware of any other Appeals or Interferences relating to the present Appeal.

III. STATUS OF CLAIMS

This Appeal is taken from the Final Rejection of claims 1, 3, 4, 5, 7, 9-10, 12, 14, 16, 20, the pending claims in the application (although the Advisory Action refers to claims "1-20"). A copy of the appealed claims is attached to this Brief as an Appendix.

IV. STATUS OF AMENDMENTS

An Amendment after the Final Rejection was filed on May 12, 2006. The Amendment was not entered by the Examiner for purposes of this Appeal. (Appellants do not understand why it was appropriate not to enter the amendment since it only combined claims and would simplify issues for appeal.)

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention set forth in the claims on appeal is directed to a superior nut butter, with a creamy characteristic, made in a form which is very spreadable and that takes less force to spread with a knife. The claimed composition has a high percentage of medium sized particles and a spreadability of about 4.915 kg to about 5.215 kg. As shown in Examples 1-8 in the Specification (beginning on p. 14, line 19 +), the claimed composition unexpectedly displays superior spreadability when compared to conventional like compositions.

In the Specification, the portion from page 1, line 4 to page 5, line 9 is background. The phraseology used in claim 1 may be found, for example, on page 11 of the Specification as originally filed. Beginning at page 14, line 19, working examples, illustrating the unexpected results and superior properties of the composition of this invention, are put forth.

Independent claim 1 describes a nut butter or nut spread composition comprising

(i) a nut ingredient,
(ii) from about 0-10% seasonings,
(iii) from about 0.5-2.5% stabilizer,
(iv) from about 0-1% emulsifier and
(v) from about 0-60% bulking agent, and

the particle size distribution of said nut butter or nut spread composition having a lower percentage of fine and coarse sized particles and a higher percentage of medium sized particles such that at least 90% of the particles are smaller than about 40 microns, at least 50% of the particles are smaller than about 10 microns, at least 10% of the particles are smaller than about 2 microns, and 1.4% of the particles are larger than 58.7 microns ,

having a span from about 4.16 to about 6.0; a Brookfield viscosity from about 6,000 to about 14,000 centipoise taken at a temperature of 85° C after 60

seconds at 20 rpm with a spindle D, heliopath; and a spreadability of from about 4.915 kg to about 5.215 kg.

The invention of claim 1 is further defined by the dependent claims which claim, among other things, the type of nut ingredient and the addition of oil where defatted nuts are used, and that the composition is a once ground composition.

Independent claim 7 is directed to a reduced fat nut spread comprising
(i) a nut ingredient wherein the nut ingredient is a peanut ingredient,
(ii) from about 0-10% seasonings,
(iii) from about 0.3-2% stabilizer,
(iv) from about 0-1% emulsifier and
(v) from about 10-60% bulking agent and the particle size distribution of said nut spread composition having a lower percentage of fine and coarse sized particles and a higher percentage of medium sized particles such that at least 90% of the particles are smaller than about 40 microns, at least 50% of the particles are smaller than about 10 microns, at least 10% of the particles are smaller than about 2 microns and 1.4% of the particles are larger than 58.7 microns wherein the composition has a spreadability of about 4.000 kg to about 5.300 kg; a Brookfield viscosity from about 6,000 to about 14,000 centipoise taken at a temperature of 85° C after 60 seconds at 20 rpm with a spindle D, heliopath; and

a span from about 2.5 to about 6.0.

The invention of claim 7 is further defined by the dependent claims which claim, among other things, the type of nut ingredient, the addition of oil *where defatted nuts are used,* and a spreadability from about 4.915 kilograms to about 5.215 kilograms, and the composition is a once ground composition.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issue raised in this appeal is primarily one of fact and of the type normally encountered in connection with a rejection made under 35 USC §103. In particular, the issue is as follows:

Would one of ordinary skill in the art, upon reading

Wong et al., U.S. Patent No. 5,693,357 (hereinafter W'357) in view of **Wong** et al., U.S. Patent No. 5,885,645 (hereinafter W'645) and further in view of **Walling** '919 and further in view of **Meade**, U.S. Patent No. 6,010,737 (hereinafter M'737); or

Wong '357 in view of **Wong** '645 and further in view of **Meade** '737

find it obvious to make a superior nut butter or nut spread composition having the unique combination of *particle size distribution, viscosity, span and spreadability* as claimed in the present invention?

VII. ARGUMENT

The Examiner has rejected claims 1, 3, 4, 5, 9-10, 12, 14, and 20 under 35 USC §103 as being unpatentable over **Wong** et al., U.S. Patent No. 5,693,357 (hereinafter '357) in view of **Wong** et al., U.S. Patent No. 5,885,645 (hereinafter '645) and further in view of **Walling** '919 and further in view of **Meade**, U.S. Patent No. 6,010,737 (hereinafter '737).

The Examiner has also rejected claims 7, 12 and 16 under 35 USC §103 as being unpatentable over **Wong** '357 in view of **Wong** '645, as applied above, and further in view of **Meade** '737.

In the rejection, the Examiner maintains, in summary, that W'357 discloses a nut butter containing nut ingredients, seasonings, stabilizer, emulsifier and bulking agents with a particle size distribution of which 90 % of the particles are less that 40 microns and 50 % of the particles are smaller than 10 microns. The Examiner admits that Claims 1, 7 and 12 differ in the limitations that 1.4 % of the particles are larger than 58.7 microns and 10 % are smaller than 2 microns, as well as in the limitation of the particular spreadability.

To cure the vast deficiencies of the primary reference W'357, Wong '645, which disclosed a process for milling nuts to various micron sizes, is cited to support existence of chunky peanut butters and for the proposition that nut spreadability is determined by particle size. The Examiner also relies on the M'737 reference, which discloses a process for milling nuts to various particle sizes, as disclosing viscosities within the claimed range and asserts that it would be obvious to use/want a viscosity as disclosed by the Meade '737 reference in the compositions described in the W'357 reference.

Furthermore, the Examiner continues to believe it is obvious to vary particle sizes to obtain a particular spreadability. The Examiner believes that nothing new is seen in a composition with particles being larger than 58.7 microns as in crunchy peanut butter and with 10 % of the particles being below 2 microns in size. The Examiner has picked Walling '919 as allegedly showing the claimed SPAN and 80 % nut solids of the claimed size. In this regard, without showing where in the references there is a suggestion or motivation to come up with the unique combination of particle size distribution and other claimed elements, the Examiner maintains that the 35 USC §103 rejection is proper and should be made final.

Notwithstanding the Examiner's apparent position to the contrary, it is, again, the Appellants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

The present invention, again, as set forth in independent claim 1, is directed to a superior nut butter made via a gap mill process to product a product which is very spreadable and that takes less force to spread with a knife. Independent claim 1 describes a nut butter or nut spread composition comprising

(vi) a nut ingredient,

(vii) from about 0-10% seasonings,

(viii) from about 0.5-2.5% stabilizer,

(ix) from about 0-1% emulsifier and

(x) from about 0-60% bulking agent, and

the particle size distribution of said nut butter or nut spread composition having a lower percentage of fine and coarse sized particles and a higher percentage of medium sized particles such that at least 90% of the particles are smaller than about 40 microns, at least 50% of the particles are smaller

than about 10 microns, at least 10% of the particles are smaller than about 2 microns, and 1.4% of the particles are larger than 58.7 microns ,

having a span from about 4.16 to about 6.0; a Brookfield viscosity from about 6,000 to about 14,000 centipoise taken at a temperature of 85° C after 60 seconds at 20 rpm with a spindle D, heliopath; and a spreadability of from about 4.915 kg to about 5.215 kg.

The invention of claim 1 is further defined by the dependent claims which claim, among other things, the type of nut ingredient and the addition of oil where defatted nuts are used, and that the composition is a once ground composition.

Independent claim 7 is directed to a reduced fat nut spread comprising

(i) a nut ingredient wherein the nut ingredient is a peanut ingredient,

(ii) from about 0-10% seasonings,

(iii) from about 0.3-2% stabilizer,

(iv) from about 0-1% emulsifier and

(v) from about 10-60% bulking agent and

the particle size distribution of said nut spread composition having a lower percentage of fine and coarse sized particles and a higher percentage of medium sized particles such that at least 90% of the particles are smaller than about 40 microns, at least 50% of the particles are smaller than about 10 microns, at least 10% of the particles are smaller than about 2 microns and 1.4% of the particles are larger than 58.7 microns wherein the composition has a spreadability of about 4.000 kg to about 5.300 kg; a Brookfield viscosity from about 6,000 to about 14,000 centipoise taken at a temperature of 85° C after 60 seconds at 20 rpm with a spindle D, heliopath; and

a span from about 2.5 to about 6.0.

The invention of claim 7 is further defined by the dependent claims which claim, among other things, the type of nut ingredient, the addition of oil *where defatted nuts are*

used, and a spreadability from about 4.915 kilograms to about 5.215 kilograms, and the composition is a once ground composition.

In contrast and as already made of record, none of the important and critical limitations set forth in the presently claimed invention are even remotely described in the '357 and '645 reference. The combination of references fails to disclose or suggest the unique claimed particle size distribution and the unique claimed visocity. The W'357 reference merely discloses a nut paste having a particular monomodial particle size distribution. The monomodial nut butters and spreads of the '357 reference typically comprise from about 50% to 100% of a nut paste with water insoluble solids comprising a particle size of less than about 21.6 microns. The '357 reference does not, even remotely, teach, suggest or describe any of the important and critical limitations set forth in independent claims 1 and 7. Particularly, there is no teaching whatsoever in the '357 reference that even remotely suggests the spreadability of the presently claimed compositions. Moreover, nothing in the '357 reference even remotely suggests the particle size distribution set forth in independent claims 1 and 7, and based on the formula in Example 5, the paste in the '357 reference will not have the span of the compositions claimed in this invention.

The deficiencies in Wong '357 are not cured by Wong '645, since it merely discloses separately milled nut solids and particular water soluble solids used to reduce stickiness and improve flavor intensity of a nut spread. Nothing in Wong '645 even remotely describes any of the limitations set forth in the presently claimed invention. *In fact, Wong '645 teaches away from the present invention by describing their achievement of a greatly reduced viscosity nut spread with a viscosity of about 2,000 centipoise or less* (Abstract, Claim 1; col 3, lines 38-40), *whereas the present invention is directed to much more viscous nut spreads. As such, the spreadability of Wong '645 is different.* Moreover, the combination of references does not suggest the span of the composition as presently claimed.

Given that *Wong '645 teaches away from the present invention by requiring a viscosity of about 2,000 centipose or less, why would one skilled in the art combine it with Meade '737 to* pick the lower range of *the viscosity according to the present invention*, while the other critical limitations are not disclosed in Meade? The invention should be viewed as a whole, rather than picking and choosing elements from a **multitude** of references. Furthermore, Meade '737 reference merely describes nut spreads having reduced fat and reduced calories *by means of using* from about 4 to about 18% of a low or no calorie triacyl-glycerol oil *to replace the natural nut oil.* In contrast, Claim 4 specifically requires native nut oil. Appellants respectfully submit that there is no suggestion or motivation to combine W'645 with M'737 in order to put together their individual pieces so as to arrive at the unique combination according to the present invention.

Applicants respectfully submit that the nut butter of Walling '919 *does not have the characteristics of the nut butter obtained through the one-step process of the present invention owing, in part, to* ***differences in particle size distribution.*** Walling specifies 80 % nut solids having a particle size of less than 18 microns, which is a completely different particle size distribution from the presently claimed amount of at least 10 % smaller than about 2 microns, at least 50 % smaller than 10 microns, at least 90 % smaller than 40 microns, and 1.4 % larger than 58.7 microns. Walling requires a span of greater than 2.5 to no more than 5, whereas the present invention goes from about 4.16 to as high as 6. The fact that some particles of Walling may be the same **size** as some particles of the nut butter of the present invention does not render the **particle size distribution** and other properties the same.

Appellants respectfully submit that it is improper for the Examiner to rely on a multitude of references and suggest that peanuts can be ground to a particular size in order to produce a particular spreadability. It is also improper for the Examiner to

conclude that specific viscosities would be obvious. The invention must be viewed as a whole, rather that picking and choosing elements from a multitude of references. That a particular feature exists somewhere in the art is not sufficient basis to reject the invention as a whole. There must be some suggestion or motivation for combining references and modifying them to come up with the invention as a whole.

Appellants respectfully submit that there is no motivation whatsoever to combine the teachings of the references relied on by the Examiner. The Examiner has combined references that describe ground nuts, all of which do not relate to one another, or even teach away from each other. Therefore, the combination of cited references does not come up with the invention as claimed in the independent claims 1 and 7, and their dependent claims, *viewed as a whole.*

In view of the above, it is again clear that the Examiner has not established a *prima facie* case of obviousness as required under 35 USC §103. When establishing a *prima facie* case of obviousness, it is fundamentally improper to gloss over important and critical claim limitations. The "invention as a whole" must be considered, including all limitations of the claimed invention. *In re Boe*, 184 U.S.P.Q. 38, 40 (C.C.P.A. 1974) ("..., all limitations must be considered and that it is error to ignore specific limitations distinguishing over the references").

Invention Must Be Viewed As A Whole

Simply combining the disclosures of the references by *picking and choosing aspects of each* is improper combination and in any case would not lead to nut spread having the claimed characteristics. An obviousness rejection is proper only when "the subject matter as a whole would have been obvious at the time the invention was made ..." (emphasis added). 35 U.S.C. 103. Applicant respectfully submits that the Office Action has improperly chosen certain aspects of one reference and combined them with

aspects of other references, without showing where the motivation is to combine them to come up with the subject matter of the present invention as a whole, within the meaning of 35 U.S.C. 103. Applicant submits that the pending claims are not obvious over the cited references, under 35 U.S.C. 103. Reconsideration and withdrawal of the rejection is respectfully requested.

W'357 must be viewed together with the other cited references to determine if they come up with the invention as a whole. Applicants respectfully submit that they do not result in the invention viewed as a whole. Nut sizes are picked from W'357, even recognizing that W'357 does not show the claimed particle size distribution. Contrary to the Examiner's position, while Wong '357 teaches ground peanuts, it fails to disclose or suggest products with the unique claimed particle size distribution, spreadability, viscosity, and span; additionally, it fails to disclose such a composition that is once ground. Wong '645 are limited to peanut butters with greatly reduced viscosities, despite containing chunks, and therefore W'645 do not remedy the deficiencies of W'357. M'737, while overlapping with the presently claimed viscosities in the lower range described therein, merely describes nut spreads using a low or no calorie triacyl-glycerol, and lacks suggestion or motivation for one skilled in the art to combine with W'645. While W'919 discloses an overlapping span range, it again fails to disclosed the claimed particle size distribution.

The Court of Appeal for the Federal Circuit has repeatedly held that when making out a *prima facie* case of obviousness, the focus must be on the invention as a whole,

> That features, even distinguishing features are "disclosed" in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have

been obvious to one of ordinary skill in the art at the time the invention was made. 35 U.S.C. 103.

Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1549, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

It is fundamentally improper for the Examiner to ignore important and critical claim limitations. The Examiner cannot ignore that the present inventions are directed to pasta compositions that uniformly cook due to the fact that they have intersections joined by a tapered portion of a leg. In view of this, it is clear that a *prima facie* case of obviousness has not been established.

The combination of references does not suggest that at least 10% of the particles present within the composition are smaller than about 2 microns and do not suggest that the composition is one which is a once ground composition. The important particle size distribution of the composition of the present invention is not suggested by the references. In view of the above, all of the important and critical limitations set forth in the presently claimed invention are not found in the combination of references.

In view of the above, Appellants submit that a proper rejection under 35 U.S.C. 103 has not been made. Accordingly, reversal of the Final Rejection by the Honorable Board is appropriate and is courteously solicited.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A nut butter or nut spread composition comprising

(i) a nut ingredient,

(ii) from about 0-10% seasonings,

(iii) from about 0.5-2.5% stabilizer,

(iv) from about 0-1% emulsifier and

(v) from about 0-60% bulking agent, and

the particle size distribution of said nut butter or nut spread composition having a lower percentage of fine and coarse sized particles and a higher percentage of medium sized particles such that at least 90% of the particles are smaller than about 40 microns, at least 50% of the particles are smaller than about 10 microns, at least 10% of the particles are smaller than about 2 microns, and 1.4% of the particles are larger than 58.7 microns wherein the composition has a span from about 4.16 to about 6.0;

said composition having a Brookfield viscosity from about 6,000 to about 14,000 centipoise taken at a temperature of 85° C after 60 seconds at 20 rpm with a spindle D, heliopath; and

said composition having a spreadability of from about 4.915 kg to about 5.215 kg.

3. The composition of claim 1 wherein the nut ingredient is nuts, nut slurry or defatted nut flour or a combination thereof or nuts and nut slurry, nuts and defatted nut flour or nut slurry and defatted nut flour.

4. The composition of claim 3 further comprising nut oil.

5. The composition of claim 1 wherein the nut ingredient is a peanut ingredient.

7. A reduced fat nut spread composition comprising

(i) a nut ingredient wherein the nut ingredient is a peanut ingredient,

(ii) from about 0-10% seasonings,

(iii)from about 0.3-2% stabilizer,

(iv) from about 0-1% emulsifier and

(v) from about 10-60% bulking agent and

the particle size distribution of said nut spread composition having a lower percentage of fine and coarse sized particles and a higher percentage of medium sized particles such that at least 90% of the particles are smaller than about 40 microns, at least 50% of the particles are smaller than about 10 microns, at least 10% of the particles are smaller than about 2 microns and 1.4% of the particles are larger than 58.7 microns wherein the composition has a spreadability of about 4.000 kg to about 5.300 kg;

said composition having a Brookfield viscosity from about 6,000 to about 14,000 centipoise taken at a temperature of 85° C after 60 seconds at 20 rpm with a spindle D, heliopath; and

wherein the composition has a span from about 2.5 to about 6.0.

9. The composition of claim 7 wherein the nut ingredient is nuts, nut slurry or defatted nut flour or a combination thereof or nuts and nut slurry, nuts and defatted nut flour or nut slurry and defatted nut flour.

10. The composition of claim 9 further comprising nut oil.

12. The composition of claim 7 having a spreadability of from about 4.915 kg to about 5.215 kg.

14. The composition of claim 1 wherein the composition is a once ground composition.

16. The composition of claim 7 wherein the composition is a once ground composition.

20. The composition of claim 7 wherein the composition has a span of 4.16 to about 6.0.

IX. EVIDENCE APPENDIX

No additional evidence had been submitted.

X. RELATED PROCEEDINGS APPENDIX

Neither the Appellants, their legal representatives nor the Assignee are aware of any proceedings relating to the present Appeal.